

## **REMARKS**

### **Restriction Requirement**

In accordance with the response to Restriction Requirement submitted by Applicant on May 16, 2005 electing claims 47-99 for examination, Applicant hereby cancels the unelected claims 44-46 without prejudice or disclaimer and reserves the right to re-enter these claims in a divisional application at a later date.

### **Claim Amendments**

Applicant has amended various claims to address the rejections, to address grammatical concerns and/or to be consistent with amendments to claims from which they depend. Applicant contends that the amendments find support in the Specification as filed and do not constitute new matter.

### **Rejections Relying on 35 U.S.C. § 102(e)**

Applicant notes that references used in support of the rejections rely on 35 U.S.C. § 102(e), either directly or through 35 U.S.C. § 103(a). In responding to the rejections, Applicant does not admit that the references are prior art and Applicant specifically reserves the right to swear behind these references at a future date. However, Applicant contends that the claims are patentably distinct from the cited references.

### **Objections to the Drawings**

The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 360 in Figure 1, 370 in Figure 1, 360 in Figure 3, 370 in Figure 3 and T3 in Figure 3.

Applicant has amended the Specification to include the missing references. Applicant contends that as the amendments to the Specification are supported in the context of the Specification and drawings as filed, they do not constitute new matter.

In the paragraph beginning on page 7 at line 4 of the Specification, Applicant has added the reference number 360 to identify the reviewing dentist's desk and the reference number 370

to identify the claims adjuster's desk. Applicant notes that the element identified as 360 in Figure 1 is labeled "Reviewing Dentist's Desk" and that the element identified as 370 in Figure 1 is labeled "Claims Adjuster's Desk" and that, as such, the amendment is supported by the application as filed.

In the paragraph beginning on page 36 at line 7 of the Specification, Applicant has added the reference numbers 360 and 370 to identify the desks of the reviewing dentist and the claims adjuster, respectively. Applicant notes that the element identified as 360 in Figure 3 is labeled "Reviewing Dentist's Desk" and that the element identified as 370 in Figure 3 is labeled "Claims Adjuster's Desk" and that, as such, the amendment is supported by the application as filed.

In the paragraph beginning on page 36 at line 18, Applicant has replaced the reference to T4 to refer instead to T3. Applicant contends that the reference to task T4 at line 21 was a clerical error and that it is clear from the description that calling up a graphics portion of the PAC application from the server 310 to a personal computer 311 is referring to the line labeled T3 in Figure 3. In addition, Applicant has inserted a reference to T4 to identify calling up a portion of the PAC application from the mainframe computer 350 using the terminal 351. Applicant contends that this reference is clear from the context of Figure 3 and its related description.

In view of the foregoing amendments to the Specification, Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

*Claim Rejections Under 35 U.S.C. § 112*

Claims 47, 51, 52, 57-66, 68, 70, 76, 79, 87, 88, 90, 93-97 and 99 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant contends that the limitations "the same fields" and "the same format" in claim 61 have sufficient antecedent basis as a transmitted file has fields and a format and claim 61 makes clear that a transmitted file to a first recipient may not have an identical set of fields or an identical format as a transmitted file to a second recipient.

Applicant contends that the limitation "said ability to directly integrate the transmitted file into the information system of the selected one of the M recipients" in claim 62 has sufficient

antecedent basis as claim 60 recites that the transmittable file generated can be digitally integrated directly into an information system of the selected one of the M recipients.

Applicant contends that the limitation “the Internet” in claim 68 has sufficient antecedent basis as it is a proper noun and it would be improper for it to be preceded by the article “a” or “an.”

Applicant contends that the limitation “the members” in claim 90 has sufficient antecedent basis in that it is inherent that a subset contain members.

Applicant contends that the limitation “the Internet” in claim 97 has sufficient antecedent basis as it is a proper noun and it would be improper for it to be preceded by the article “a” or “an.”

Applicant has amended the claims to address the other rejections under 35 U.S.C. § 112, second paragraph. In view of the foregoing amendments and arguments, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, and allowance of claims 47, 51, 52, 57-66, 68, 70, 76, 79, 87, 88, 90, 93-97 and 99.

*Claim Rejections Under 35 U.S.C. § 101*

Claims 47-99 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Office Action asserted, “The language of claims 47-99 raises a question as to whether the claimed graphical user interfaces are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101.” Applicant respectfully traverses.

Applicant contends that each of the independent claims 47, 52, 88 and 90 are statutory subject matter as each GUI is responsive to entered data to cause a functional change in a computer, e.g., selecting a format of the generated file or selecting what fields will accept further data entry. Applicant contends that such a transformation is concrete, useful and tangible and is thus statutory subject matter under 35 U.S.C. § 101. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 101, and allowance of claims 47-99.

*Double Patenting Rejection*

Claims 47-50, 52, 53, 67-74, 79, 91 and 97 were provisionally rejected under the judicially created obviousness-type double patenting as being unpatentable over claims 5, 6, 8, 9, 10, 12, 13, 15, 16, 17, 19, 20, 23, 24, 26 of U.S. Patent No. 6,343,310 in view of Guzik et al. (U.S. Patent 6,055,333). Applicant hereby submits a terminal disclaimer to overcome the rejection. Applicant has included a Terminal Disclaimer herewith to address the rejection. In view of the Terminal Disclaimer, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claims 47-50, 52, 53, 67-74, 79, 91 and 97.

*Claim Rejections Under 35 U.S.C. § 102*

Claims 47-54, 64-66, 72-75, 88-92, 94-96 and 98 were rejected under 35 U.S.C. § 102(e) as being anticipated by Guzik et al. (U.S. Patent No. 6,055,333). Applicant respectfully traverses.

The Office Action asserts, “[A]s demonstrated in the cited text, the data-accepting fields is determined by data entered into a field.” Office Action, page 9, first bullet point. Applicant contends this is a misinterpretation of the reference. Applicant acknowledges that Guzik et al. states that upon determining a field receiving input, a set of dictionaries associated with that field is activated. Guzik et al., column 4, lines 15-18. However, the data-accepting status of the fields is not altered in response to the received input, nor is there any teaching or suggestion that a format of a generated file is selected in response to the received input.

Claims 47 and 52 recite, in part, “at least one of a file format of the file and a subset of the N fields that will be data-accepting fields is determined responsive to data entered into a first predetermined one of the N fields.” As Guzik et al. does not determine a file format of a generated file in response to data entered into a field and does not determine which of its fields will be data-accepting fields in response to data entered into a field, the cited reference cannot teach or suggest at least this element of claims 47 and 52.

Claim 88 recites, in part, “at least one of the selected one of the formats and members of the active subset is determined responsive to data entered into a first of the N data-accepting fields.” As Guzik et al. does not select a file format of a generated file in response to data entered into a field and does not determine which of its fields will be data-accepting fields in

response to data entered into a field, the cited reference cannot teach or suggest at least this element of claim 88.

Claim 90 recites, in part, “at least one of the selected one of the R formats and the members of the active subset is determined responsive to data entered into a predetermined one of the N data-accepting fields.” As Guzik et al. does not select a file format of a generated file in response to data entered into a field and does not determine which of its fields will be data-accepting fields in response to data entered into a field, the cited reference cannot teach or suggest at least this element of claim 90.

In view of the foregoing, Applicant respectfully submits that it has shown independent claims 47, 52, 88 and 90 to be patentably distinct from the cited reference. As claims 48-51 include all patentable limitations of claim 47; claims 53-54, 64-66 and 72-75 include all patentable limitations of claim 52; claim 89 includes all patentable limitations of claim 88; and claims 91-92, 94-96 and 98 include all patentable limitations of claim 90, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(e), and allowance of claims 47-54, 64-66, 72-75, 88-92, 94-96 and 98.

*Claim Rejections Under 35 U.S.C. § 103*

Claims 55, 56 and 59

Claims 55, 56 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Rossmann (U.S. Patent No. 6,625,447). Applicant respectfully traverses.

Applicant contends that it has shown claim 52 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Rossmann fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52. In particular, although the Office Action asserts that “Rossmann teaches specifying which fields will accept data for that recipient (col. 26, lines 1-10),” Applicant notes that the fields referred to in Rossmann are not fields for data entry, but rather commands controlling information transfer between a server and a cellular telephone. *See*, Rossmann, column 25, line 49 through column 26, line 10. In addition, although the Office Action asserts that “Rossmann teaches specifying the format for that recipient (col. 26, lines 1-10),” Applicant contends that Rossmann does not purport to specify a file format responsive to data entered into a predetermined one of two or

more fields. Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claim 52. As claims 55, 56 and 59 include all patentable limitations of claim 52, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 55, 56 and 59.

#### Claims 57 and 58

Claims 57 and 58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Cauffman et al. (U.S. Patent No. 5,325,290). Applicant respectfully traverses.

Applicant contends that it has shown claim 52 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Cauffman et al. fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52. In particular, Applicant finds no teaching or suggestion that Cauffman et al. selects file formats or selects which data entry fields are data accepting in response to the entry of data into a first predetermined data-accepting field. Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claim 52. As claims 57 and 58 include all patentable limitations of claim 52, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 57 and 58.

#### Claims 60-63, 68-71, 93 and 97

Claims 60-63, 68-71, 93 and 97 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Loveria, III (U.S. Pub. No. 20040090466). Applicant respectfully traverses.

Applicant contends that it has shown claims 52 and 90 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Loveria, III fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52 or claim 90. In particular, Applicant finds no teaching or suggestion that Loveria, III selects file formats or selects which data entry fields are data accepting in response to the entry of data into a predetermined data-accepting field. Accordingly, either taken alone or in combination, the cited

references fail to teach or suggest each and every limitation of claim 52 or claim 90. As claims 60-63 and 68-71 include all patentable limitations of claim 52, and claims 93 and 97 include all patentable limitations of claim 90, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 60-63, 68-71, 93 and 97.

#### Claim 67

Claim 67 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Aldrich et al. (U.S. Patent 5,138,698). Applicant respectfully traverses.

Applicant contends that it has shown claim 52 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Aldrich et al. fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52. In particular, Applicant finds no teaching or suggestion that Aldrich et al. selects file formats or selects which data entry fields are data accepting in response to the entry of data into a first predetermined data-accepting field. Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claim 52. As claim 67 includes all patentable limitations of claim 52, this claim is also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claim 67.

#### Claims 76-80

Claims 76-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Goltra (U.S. Patent 5,802,495). Applicant respectfully traverses.

Applicant contends that it has shown claim 52 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Goltra fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52. In particular, Applicant finds no teaching or suggestion that Goltra selects file formats or selects which data entry fields are data accepting in response to the entry of data into a predetermined data-accepting field.

Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claim 52. As claims 76-80 include all patentable limitations of claim 52, these claims are also believed to be allowable. Applicant thus respectfully requests

reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 76-80.

#### Claims 81-86

Claims 81-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Laszlo (U.S. Patent 5,331,547). Applicant respectfully traverses.

Applicant contends that it has shown claim 52 to be patentably distinct from the primary reference of Guzik et al. The secondary reference of Laszlo fails to overcome the deficiencies of the primary reference as discussed with reference to claim 52. In particular, Applicant finds no teaching or suggestion that Laszlo selects file formats or selects which data entry fields are data accepting in response to the entry of data into a predetermined data-accepting field.

Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claim 52. As claims 81-86 include all patentable limitations of claim 52, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 81-86.

#### Claims 87 and 99

Claims 87 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Rossmann in further view of Loveria. Applicant respectfully traverses.

Applicant contends that it has shown claims 52 and 90 to be patentably distinct from the primary reference of Guzik et al. Applicant further contends that it has shown claim 52 to be patentably distinct from the combination of Guzik et al. and Rossmann. For similar reasoning, Applicant contends that claim 90 is also patentably distinct from the combination of Guzik et al. and Rossmann. In particular, although the Office Action asserts that “Rossmann teaches specifying the format for that recipient (col. 26, lines 1-10),” Applicant contends that Rossmann does not purport to specify a file format responsive to data entered into a predetermined one of two or more fields. The tertiary reference of Loveria, III further fails to overcome the deficiencies of the primary and secondary references in that Applicant finds no teaching or suggestion that Loveria, III selects file formats or selects which data entry fields are data accepting in response to the entry of data into a predetermined data-accepting field.



Accordingly, either taken alone or in combination, the cited references fail to teach or suggest each and every limitation of claims 52 and 90. As claim 87 includes all patentable limitations of claim 52, and claim 99 includes all patentable limitations of claim 90, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 87 and 99.

### CONCLUSION

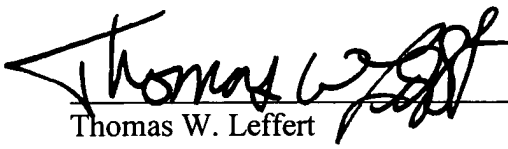
Claims 44-46 are canceled hereby without prejudice or disclaimer. Claims 47-53, 57-60, 63-66, 68, 70, 76, 79, 87, 88, 90, 93-97 and 99 are amended herein. Claims 47-99 are now pending.

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2204.

Please deem this a petition for extension of time if necessary to maintain pendency of this patent application. Please charge any additional fees necessary to maintain pendency of this patent application or credit any overpayment to Deposit Account No. 501373.

Respectfully submitted,

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